

## **REMARKS**

### **Status of Claims**

This Response is filed to respond to all issues raised in the Office Action mailed November 7, 2003.

In the Office Action, Claims 1-16, 18-27, 29-33, 35-53, and 55-59 were noted as pending in the application and all Claims were rejected under 35 U.S.C. 103(a). The rejection is addressed below.

By the present Amendment, new Claims 60-76 have been added to the subject application. The reasons the Claims 60-76 are patentable over the prior art are also addressed below.

### **Response to Examiner's Statements**

On page 2, item 2 of the Office Action, the Examiner asserts that the LEADTOOLS document is a publication within the meaning of 35 U.S.C. 102(b). Applicant reiterates its objections to the LEADTOOLS website document being considered evidence of a publication of the invention under 35 U.S.C. 102(b) for reasons previously made of record, e.g., it is an out-of-court statement made without benefit of anyone under oath to explain what it is, how it was compiled, when and by whom it was compiled, whether the web crawler of the Internet Archive is prone to error, whether there are other reasons that the date of posting of website content may not actually be the date of publication of the document, whether the document constitutes 'prior art' under 35 U.S.C. 102(b), etc. For example, if one inputs the address "<http://web.archive.org/web/19981206103323/www.leadtools.com>," one is redirected to "<http://web.archive.org/web/19981206230916/www.leadtools.com/>" which contains different content than that provided with the previous Office Action.

However, if the Examiner continues to assert the LEADTOOLS website document as prior art, then Applicant requests the Examiner to concede that the documents offered by Applicant as objective evidence of non-obviousness are likewise cognizable evidence as they were obtained from the same Internet Archive / Wayback Machine from which the Examiner obtained the LEADTOOLS website document.

On page 3, item 3 of the Office Action, the Examiner contends that the Examiner's conclusion of obviousness using hindsight reasoning is proper so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, citing the 1971 case of *In re McLaughlin* for this proposition. On this issue, Applicant reiterates its position made even more clear by the present claim amendments that the claimed invention would not have been obvious to a person of ordinary skill in the art at the time the invention was made. For example, with respect to Claim 1, there is simply no disclosure in the LEADTOOLS document of "generating a display based on a hypertext mark-up language (HTML) document using a web browser of a user interface of a client device, which display includes a document display portion, and index field portion, and a control portion **all visibly defined by the HTML document.**" Claim 1 further recites "...the document display portion including a display of document data **representing the scanned document**, the index field portion permitting index data to be input to the user interface in association with the document data, and the control portion including at least one control element for generating a start scan signal to initiate scanning of a document with a scanner to generate the document data and a send data signal to transmit the document data with the index data displayed by the web browser from the client device to a server **over a network.**"

Although the Examiner relies upon vague statements in the LEADTOOLS disclosure, many of which Applicant contends have been misinterpreted, it should be appreciated that the LEADTOOLS disclosure pertains to a toolkit for developing software applications. The purpose of this toolkit is to provide the application developer with access to "...more than 600 functions, properties and methods, in 16 imaging categories..." so that the developer can pick and choose, define, and combine those functions to develop an application. Hence, like any development toolkit, the teaching or motivation to combine the numerous functions, properties and methods, must be provided by the application developer, not by the toolkit itself. Nowhere does the Examiner contend that any developer ever used the LEADTOOLS disclosure to permit application developers to pick and choose functions, define them, and combine them together to produce an application anything like the claimed invention. The only source of record that could be used to provide such teaching, motivation, or suggestion is Applicant's disclosure. The

Examiner has thus engaged in impermissible hindsight by using Applicant's disclosure against the Applicant. In addition, many significant features of the claimed invention are not disclosed in the LEADTOOLS disclosure, nor would they be obvious in view thereof. These deficiencies of the LEADTOOLS disclosure will be addressed more fully below.

On page 4, item 4 of the Office Action, the Examiner acknowledges, and Applicant agrees, that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The Examiner agrees with Applicant that the LEADTOOLS does not expressly disclose "...the display including a control portion ... including at least one control element for generating a start scan signal to initiate scanning of a document with a scanner to generate the document data and a send data signal to transmit the document data with the index data displayed by the web browser from the client device to a server ...." The Examiner alleges that "LEADTOOLS discloses the start scan signal and send data signal as disclosed above. In fact, the "LEADTOOLS" disclosure fails to even mention any start scan signal or send data signal, or anything comparable to them. The Examiner further alleges that ""LEADTOOLS" also discloses that control portions of any and all functions disclosed within "LEADTOOLS" may be created in order to have a customized display"" and cites the LEADTOOLS Imaging Common Dialogs section of the LEADTOOLS disclosure as providing support for this statement. In fact, "LEADTOOLS Imaging Common Dialogs" states as follows:

**LEADTOOLS Imaging Common Dialogs** - The LEADTOOLS Imaging Common Dialog Boxes are a set of re-usable dialog boxes with LEADTOOLS specific options.

The Imaging Common Dialog boxes provided by LEADTOOLS extend the Windows common dialogs for FileOpen and FileSave to provide imaging specific capabilities.

*The LEADTOOLS Imaging Common Dialogs also provide input dialog boxes for all of the LEADTOOLS image processing functions. These dialogs allow you to quickly and easily enable your application to gather input from end-users for the parameters required by the various LEADTOOLS functions. These dialogs can also be used to automatically process the image based on end-user input (thus reducing the amount of code you have to write). You can use the LEADTOOLS Common Dialogs to greatly simplify programming development, save you hours of tedious programming time, and provide a consistent look and feel for all your applications. Emphasis added.*

This section does not state that one can use LEADTOOLS dialog boxes to create a control element visible in an HTML document displayed by a web browser, that can be used to generate a start scan signal to initiate a scan of a document or a send data signal to transmit the document data representing the scanned document, from a client device to a server over a network, as recited in Claim 1. To the contrary, according to the LEADTOOLS excerpt, the Dialog Boxes can be used to gather input from end users for parameters required by the LEADTOOLS functions, and can also be used to solicit end-user input to automatically process the image. But this does not mean that any end-user or developer ever used to toolkit to produce an application that provides the features of the claimed invention. If anything, this LEADTOOLS excerpt emphasizes that developer and end-user input must be provided in order to have the motivation to combine features of the LEADTOOLS toolkit if any effort to obtain the claimed invention were to be made. There is no evidence of record that any developer or end-user ever provided such motivation to combine features of the LEADTOOLS toolkit. Thus, it can only have been the Applicant's disclosure that provided such motivation, in contravention to well-established law concerning obviousness under 35 U.S.C. 103(a). In addition, the teaching, suggestion, or motivation to combine features in an effort to obtain the claimed invention must be "...clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, \_\_\_\_ (Fed. Cir. 1999). As one can readily determine from the above LEADTOOLS excerpt, the disclosure of any display portion, index portion, and control portion in an HTML document as defined above is not shown at all, let alone with any clarity or particularity. Thus, a prima facie case of obviousness has not been made, and Applicant respectfully traverses the rejection under 35 U.S.C. §103(a).

On page 5, item 5 of the Office Action, the Examiner appears to assert that “generating a display based on a hypertext mark-up language (HTML) document using a web browser of a user interface of a client device, the display including a document display portion, and index field portion, and a control portion **all visibly defined in the display by the HTML document**” is described in the LEADTOOLS disclosure. The LEADTOOLS excerpts relied upon by the Examiner state:

LEADTOOLS offers the widest variety of imaging technology available in a single integrated development toolkit LEADTOOLS contains more than 600 functions, properties and methods, in 16 imaging categories. LEADTOOLS provides low level functions for complete control and high level functions for ease of use. *The imaging technology covered in LEADTOOLS includes support for scanning, color conversion, display/special effects, annotation, image processing (over 60 filters) with region of interest, compression, image format import/export filters (most comprehensive in the industry), imaging common dialogs, Internet/Intranet imaging, database imaging, printing, OCR, screen capture, multimedia, and FlashPix extension support, making it the most feature rich toolkit on the market.* Industry leaders use LEADTOOLS because they know that competing products offer only a fraction of the functionality needed. You can continue to count on LEADTOOLS’ maturity, stability, and if needed, it’s first class, FREE technical support.

Scanning , Color Conversion, Display / Special Effects, Annotation, Image Processing, Compression, Import/Export Filters, Imaging Common Dialog, Internet/Intranet, Database Imaging, Printing, OCR, Screen Capture, Multimedia, Medical Imaging and FlashPix Extensions

**Internet/Intranet Imaging** - LEADTOOLS features a Net Aware ActiveX and a Netscape plug-in for Internet/intranet applications. The ActiveX includes a Bitmap Datapath feature, *which allows images to be read from any URL. The ActiveX also includes an AnnDataPath feature, which allows LEADTOOLS annotation files to be loaded from any URL.* LEADTOOLS includes support for Progressive JPEG, Progressive CMP, and interlaced GIF, *so you can display images as they are downloaded.* GIF support also includes transparency, animation, and embedded text. The GIF code has support for 1 through 8 bits per pixel files. *A FeedLoad*

***function is included to allow image data to be displayed as it is being transmitted across the net, providing Internet programmers with the fastest way to begin painting the client's screen. Examples for VB script and Java script are included to assist you in incorporating images into Internet applications. Emphasis added.***

Incidentally, note that the first excerpt does not now appear to be present at the web address "<http://web.archive.org/web/19981206103323/www.leadtools.com>" indicated at the top of the LEADTOOLS disclosure provided by the Examiner. The Examiner relies upon the first LEADTOOLS excerpt to make the connection that imaging technology covered in LEADTOOLS includes support for "Internet/Intranet Imaging" which is the title of the second LEADTOOLS excerpt. The LEADTOOLS disclosure's mention of a Net Aware ActiveX and a Netscape plug-in for Internet/intranet applications does not mean that a web browser such as Internet Explorer or Netscape Navigator is used with an application developed using LEADTOOLS toolkit. To the contrary, it likely compels the conclusion that a web browser is not used in the LEADTOOLS disclosure. Thus, it is not surprising that the LEADTOOLS disclosure contains no mention of a browser. Accordingly, the claimed invention would not have been obvious to a person of ordinary skill in the art.

Also, notice that, to the extent that the LEADTOOLS disclosure can be understood as "clear and particular" as required by *In re Dembiczak*, the second LEADTOOLS excerpt appears to disclose flow from server to client device, not the other way around. Specifically, the statements from the second LEADTOOLS excerpt stating:

- (1) "The ActiveX includes a Bitmap Datapath feature, which allows images to be read from any URL";
- (2) "The ActiveX also includes an AnnDataPath feature, which allows LEADTOOLS annotation files to be loaded from any URL";
- (3) "LEADTOOLS includes support for Progressive JPEG, Progressive CMP, and interlaced GIF, so you can display images as they are downloaded."; and
- (4) "A FeedLoad function is included to allow image data to be displayed as it is being transmitted across the net, providing Internet programmers with the fastest way to begin painting the client's screen."

all appear, to the extent they can be understood, to indicate download of images from server to client. At the very least, these statements do not indicate with clearness and particularity the opposite flow from client to server. In contrast, Claim 1 recites:

generating a display based on a hypertext mark-up language (HTML) document using a web browser of a user interface of a client device, the display including a document display portion, an index field portion, and a control portion **all visibly defined in the display by the HTML document**, the document display portion including a display of document data **representing the scanned document**, the index field portion permitting index data to be input to the user interface in association with the document data, and the control portion including at least one control element for generating a start scan signal to initiate scanning of a document with a scanner to generate the document data and a send data signal to transmit the document data with the index data displayed by the web browser from the client device to a server **over a network**.

The LEADTOOLS document fails to disclose a control element defined within an HTML document along with an index field portion that can be used to enter index data, and a display portion for displaying a scanned document, that can be used to control a scanner to generate the document data and also to upload such document data to a server over a network, as recited in Claim 1 as amended. Therefore, the claimed invention would not have been obvious to a person of ordinary skill in the art at the time the invention was made.

On page 5, item 6 of the Office Action, the Examiner traverses Applicant's statement that the LEADTOOLS disclosure "teaches away" from the use of the invention within a web browser. Relative to the issue of "teaching away" from the claimed invention, the Applicant's statement was:

Furthermore, the LEADTOOLS toolkit information "teaches away" from the claimed invention. In the Scanning section, the LEADTOOLS toolkit information states "With LEADTOOLS, *your application* can acquire images from TWAIN compliant devices..." This statement clearly implies that "your application" is not a web browser, but rather is an application developed by the user with the LEADTOOLS toolkit.

Applicant's statement is indeed true – “your application” is not being used to mean “web browser,” nor does the LEADTOOLS Scanning section even mention a web browser, or for that matter, anything to do with the Internet or Web communications. The LEADTOOLS Scanning section states:

**Scanning** - LEADTOOLS supports high speed scanning using both ISIS and TWAIN industry standards for image acquisition in document (halftone), grayscale or color modes.

LEADTOOLS' TWAIN support includes both 16 & 32 bit native and buffered RAM transfer modes. Developers have the option of using the default TWAIN interface provided by the TWAIN datasource, or they can choose to by-pass the user interface to create their own, as long as the driver supports it. The LEADTOOLS TWAIN functions offer control over image size, position, brightness, contrast, resolution, and orientation. Support for single and multi-page acquire is provided. With LEADTOOLS, your application can acquire images from TWAIN compliant devices such as scanners, capture cards, and digital cameras from manufacturers like Kodak, Hewlett Packard, Microtek, Logitech, Fuji and many more.

With LEADTOOLS' support for ISIS®, developers can use the driver's built-in dialog box for controlling the image acquisition or by-pass it and create their own. The LEADTOOLS ISIS support functions offer control over image size, position, brightness, contrast, resolution, orientation, gamma and compression. Developers can request compressed data from the ISIS driver, for faster image acquisition. LEADTOOLS supports single page acquire to memory, multipage acquire to multipage file, and multipage acquire to multiple single page files. With LEADTOOLS, your application can acquire images from ISIS compliant scanners from manufacturers like Ricoh, Hewlett Packard, Bell&Howell, and others. You can use images acquired as document (halftone), grayscale or color for use in check & form processing applications, stock photo collections, WebPages and more.

*ISIS support is only available in the 32 bit portion of Express versions.*



There is no “clear and particular” disclosure in the LEADTOOLS Scanning section, as required by *In re Dembiczak*, that even suggests that the scanning could be done in such a way as to display document data representing the scanned document within an HTML document displayed within a browser. There is no “clear and particular” teaching, suggestion, or motivation in the LEADTOOLS Scanning section that any of its features can be combined with features of the LEADTOOLS Internet / Intranet Imaging Section to obtain the claimed invention. Absent this “clear and particular” disclosure, the rejection under 35 U.S.C. 103(a) must be withdrawn.

On page 5, item 7 of the Office Action, the Examiner alleges that the “LEADTOOLS” disclosure teaches all aspects of the claimed invention. To the contrary, Applicant demonstrates that the LEADTOOLS disclosure fails to disclose the claimed invention, as described in further detail below.

**Rejection of Claims 1-16, 18-27, 29-33, 35-53, and 55-59 under 35 U.S.C. §103(a) based on the LEADTOOLS Disclosure**

On pages 2-18, items 8-13 of the Office Action, Claims 1-16, 18-27, 29-33, 35-53, and 55-59 were rejected under 35 U.S.C. §103(a) based on the “LEADTOOLS” disclosure by Lead Technologies, Inc. Claims 1-16, 18-27, 29-33, 35-53, and 55-59 have been amended as necessary to overcome the rejection, as indicated below.

**A. No *Prima Facie* Case of Obviousness under 35 U.S.C. §103(a) has been Established**

The determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *In re Dembiczak*, 175 F.2d 994, 998 (Fed. Cir. 1999) (*citing Graham v. John Deere, Inc.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 USPQ 459, 465 (1966)).

The Examiner has the burden of establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a). *Ex Parte Martin P. Hageman and Thomas J. Palus*, Appeal No. 2000-1514, Application No. 09/038,450 (*citing In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)); *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only if the Examiner satisfies this initial burden does the burden of coming forward with evidence shift to

the Applicant. *Id.* The Examiner can satisfy this burden by showing some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 87 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). A *prima facie* case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1998) and *In re Litner*, 458 F.2d 1013, 1016, 173 U.S.P.Q. 560, 562 (CCPA 1972).

Even assuming for the sake of argument that the Office Action is correct regarding the disclosures of the “Scanning”, “Display”, Internet/Intranet Imaging”, “Database Imaging”, and “LEADTOOLS Imaging Common Dialogs” sections of the LEADTOOLS disclosure (to the contrary, Applicant asserts below that the Office Action is not correct in these assertions), there is no evidence that anyone ever combined these features to produce a web application that includes scanning, indexing, and/or uploading capabilities, all from within a browser. In fact, according to the LEADTOOLS information, “LEADTOOLS contains more than 600 functions, properties and methods, in 16 imaging categories.” The LEADTOOLS disclosure mentions “scanning,” “color conversion,” “display,” “special effects,” “annotations,” “image processing,” “compression,” “image format import/export filters,” “internet/intranet imaging,” “database imaging,” “imaging common dialogs,” “printing,” “OCR,” “screen capture,” “multimedia,” and “medical imaging” features. There is no motivation or suggestion that would have led a person of ordinary skill in the art to select certain of these features, then combine them as done in the Office Action in an effort to obtain the claimed invention. This is impermissible use of hindsight reasoning, in effect using Applicant’s own teachings against the Applicant. The Board of Patent Appeals and Interferences has held that “...although a prior art device may be capable of being modified to run in the manner claimed, there must be suggestion or motivation in the reference to do so.” *Ex Parte Martin P. Hageman and Thomas J. Palus*, Appeal No. 2000-1514, Application No. 09/038,450 (citing *In re Mills*, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990), and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984). Accordingly, the Office Action has not established a *prima facie* case of obviousness, and the rejection of Claims 1-16, 18-27, 29-33, 35-53, and 55-59 under 35 U.S.C. §103(a) is respectfully traversed for this reason.

Furthermore, the LEADTOOLS disclosure “teaches away” from the claimed invention. In the Scanning section, the LEADTOOLS disclosure states “With LEADTOOLS, *your application* can acquire images from TWAIN compliant devices...” This statement clearly implies that “your application” is not a web browser, but rather is an application developed by the user with the LEADTOOLS toolkit. Accordingly, not only does the LEADTOOLS disclosure fail to disclose scanning, indexing, and/or uploading capabilities, all from within a browser, as recited in Claims 1-16, 18-27, 29-33, 35-53, and 55-59, it also teaches away from such features. Thus, the rejection of Claims 1-16, 18-27, 29-33, 35-53, and 55-59 under 35 U.S.C. §103(a) based on the LEADTOOLS disclosure is respectfully traversed for this additional reason.

**B. Claims 1-16, 18-27, 29-33, 35-53, and 55-59 As Amended Would Not Have Been Obvious to a Person of Ordinary Skill in the Art and thus are Patentable over the Prior Art**

The LEADTOOLS disclosure fails to disclose a web application that includes scanning, viewing, indexing, and uploading capabilities for scanned documents provided by respective portions of a display generated with an HTML document, all from within a browser. More specifically, Claim 1 as amended recites “...generating a display based on a hypertext mark-up language (HTML) document using a web browser of a user interface of a client device, the display including a document display portion, an index field portion, and a control portion all visibly defined in the display by the HTML document ...”; Claims 9 and 27 recite “...generating a start scan signal using a control element defined by a hypertext mark-up language (HTML) document displayed by a web browser of a user interface of a client device...”; Claim 41 recites “...the processor operating under a predetermined control program stored in the memory to generate a display based on a hypertext mark-up language (HTML) document on the display unit, the display generated by the HTML document including a document display portion, an index field portion, and a control portion”; Claim 50 recites “...the client device having a user interface capable of generating a display by execution of an hypertext mark-up language (HTML) document by the client device, the display including a document display portion, an index field portion, and a control portion...”; and Claim 55 recites “...the client device receiving the document data from the scanner and generating a display of the document data in the browser thereof”; and Claim 57 recites “...generating a display including a

view of a scanned document with a browser of a client device based on document data derived from a scan of a document.” None of these features are disclosed in the LEADTOOLS disclosure. Accordingly, it is submitted that Claims 1-16, 18-27, 29-33, 35-53, and 55-59 are patentable over the prior art.

More specifically, Claim 1 recites:

generating a display based on a hypertext mark-up language (HTML) document using a web browser of a user interface of a client device, the display including a document display portion, an index field portion, and a control portion **all visibly defined in the display by the HTML document**, the document display portion including a display of document data **representing the scanned document**, the index field portion permitting index data to be input to the user interface in association with the document data, and the control portion including at least one control element for generating a start scan signal to initiate scanning of a document with a scanner to generate the document data and a send data signal to transmit the document data with the index data displayed by the web browser from the client device to a server **over a network**.

The LEADTOOLS disclosure fails to disclose generating any display based on an HTML document using a web browser, in which the display defines a document display portion, index field portion, and a control portion all visibly defined in the display by the HTML document within the web browser. The Office Action relies upon the “Scanning,” “Display,” “Internet/Intranet Imaging,” “Database Imaging,” and “LEADTOOLS Imaging Common Dialogs” sections of the LEADTOOLS disclosure. As conceded in the Office Action, the LEADTOOLS disclosure fails to disclose “...at least one control element for generating a start scan signal to initiate scanning of a document with a scanner to generate the document data and a send data signal to transmit the document data with the index data displayed by the web browser from the client device to a server” as recited in Claim 1. The Office Action alleges that the “start scan signal” and the “send data signal” are disclosed in the LEADTOOLS disclosure, and appears to rely upon the “LEADTOOLS Imaging Common Dialogs” section to somehow relate these signals to an undisclosed control element in the absence of any teaching or suggestion, other than Applicant’s disclosure, as to how this could be done. To the contrary, there is no support for any “start scan signal” or “send data signal” in the LEADTOOLS disclosure. More

specifically, the LEADTOOLS imaging common dialogs section mentions use of dialog boxes to gather input from end-users for parameters to be used in “your application” (thus, not a web browser). It does not mention a “start scan signal” or “send data signal,” let alone generated by a control element defined in an HTML display within a web browser. Although it does discuss image acquisition, the “Scanning” section of the LEADTOOLS disclosure fails to mention anything regarding control of a scanner, let alone using a control element defined on a display within a browser to control a scanner. The “Display” section in the LEADTOOLS disclosure states that images can be “scaled, zoomed, or scrolled when displayed” but none of this can be done with a control element defined in a display within a web browser. The “Annotations” section references “annotations (document markup) that can be added to a document, grayscale or color image.” It also mentions that annotation objects can be hyperlinked to open WebPages, run a specified application, or can be used to fire a user-defined event. However, it does not mention any index field portion for inputting index data into a display within a web browser. Moreover, “index data” is defined in this application as “a document name or identification number, an index path indicating a subdirectory to which the scanned document is to be stored in a server upon upload, or text explaining the nature of the document or matter or transaction to which the document relates.” None of these things are mentioned in the “Annotations” section of the LEADTOOLS disclosure. The “Internet/Intranet Imaging” feature of the LEADTOOLS disclosure states that the ActiveX plug-in includes features which allow images and annotation files to be read from any URL. However, the LEADTOOLS toolkit fails to disclose the opposite flow, that is, uploading annotated images files from a client device to a remote server via the Internet, let alone one in which the sizing, scale, adjustment, scan mode (multi- or single-scan), indexing, viewing and optionally adjusting, uploading and other functions, are controlled from within a web browser. The “Database Imaging” section relates to storing and/or retrieving an image to/from a database, which is not relevant to Claim 1 as amended. In addition, the Office Action states ““LEADTOOLS” also discloses that control portion of any and all functions disclosed within “LEADTOOLS” may be created in order to have a customized display on a web browser.” To the contrary, as noted hereinabove, none of the LEADTOOLS disclosure sections relied upon by the Examiner disclose anything even remotely like a control portion with a control element that is defined in an HTML document displayed within a web browser, that is

used to generate a start scan signal to control a scanner to scan a document, and a send data signal to upload document data representing the scanned document to a server over a network. The above detailed analysis of the LEADTOOLS disclosure reveals its many deficiencies and its failure to disclose the features of Claim 1 as amended. The LEADTOOLS disclosure thus fails to provide "clear and particular" disclosure of the claimed invention as required by *In re Dembiczak*. The ability to control the scanning, indexing, and uploading documents using control elements defined within a web browser greatly simplifies work of "coders," for example, who require these features in their work. The fact that the control of the scanner, view and optionally adjust, indexing of the scanned document, and upload to a server, can all be done within the browser is a great benefit to enhancing speed and efficiency in the coding process. Thus, it is submitted that Claim 1 as amended would not have been obvious to a person of ordinary skill in the art, and thus is patentable over the prior art.

Claims 2-8 depend, directly or indirectly, from Claim 1 as amended and include all limitations of that Claim plus additional limitations that are not disclosed in the prior art. For example, Claim 2 states that "a control element used to alternately generate the start scan signal and the send data signal with respective successive activations of the control element." The "Display" section in the LEADTOOLS disclosure states that images can be "scaled, zoomed, or scrolled when displayed" but none of this can be done with a control element defined in a display within a web browser. As mentioned in previous Amendments, this feature enables a coder to rapidly index and upload documents without having to move an input device such as a mouse to control the scanner to scan a document, then upload the scanned document to a server. This feature thus saves significant time and streamlines the coding process. Claims 3-8 are directed to adjusting the scale of a scanned document (Claim 3) by zooming in (Claim 4), zooming out (Claim 5), fitting the document within the display portion of the user interface (Claim 6), scaling to the same scale as the scanned document (Claim 7), or selecting one of a plurality of scanned documents (Claim 8), all using a control element defined in an HTML document display within a web browser. The prior art fails to disclose these features, which greatly simplify and speed the operations of coders, for example. Thus, for this reason as well as those stated above with respect to Claim 1, Claims 2-8 would not have been obvious to a person of ordinary skill in the art, and thus are patentable over the prior art.

Claim 9 recites "...generating a start scan signal using a control element defined by a hypertext mark-up language (HTML) document displayed by a web browser of a user interface of a client device..." As explained above, the LEADTOOLS disclosure fails to even mention generating a start scan signal within an HTML document displayed by a web browser. Contrary to statements in the Office Action, the LEADTOOLS disclosure fails to disclose generating a start scan signal within a web browser in the "Internet/Intranet Imaging" section, nor does it disclose any interface that uses any of the functions of LEADTOOLS within a web browser. The "LEADTOOLS Imaging Common Dialogs" section mentions use of dialog boxes to solicit parameters from a user using "your application" (presumably developed with the toolkit), not a web browser, for use in LEADTOOLS functions. The LEADTOOLS Scanning Section states that developers have the option of using the default TWAIN interface provided by the TWAIN datasource (hence, not a web browser) or may by-pass the user interface to create their own (not described in the LEADTOOLS disclosure to be a web browser, nor would a developer create their own web browser). In addition, Claim 9 recites "...at the client device, converting the start scan signal into a form compatible with a scanner..." Necessarily, the LEADTOOLS disclosure fails to disclose this feature, since it does not disclose generating a start scan signal to control a scanner, but merely addresses "image acquisition." Furthermore, Claim 9 recites "transmitting the converted start scan signal from the client device to the scanner," "receiving the converted start scan signal at the scanner," and "scanning a document with the scanner to generate document data," none of which are disclosed in the LEADTOOLS disclosure. These features of the claimed invention make it possible for a coder, for example, to control a scanner from within a web browser, greatly facilitating coding operations. Accordingly, Claim 9 would not have been obvious to a person of ordinary skill in the art, and thus is patentable over the prior art.

Claims 10-16 and 18-26 depend from Claim 9 and include all of the limitations of that Claim plus additional limitations that are not taught or even suggested by the prior art. For example, Claim 10 recites that the start scan signal is generated "...by depressing and releasing the control element of the user interface defined by the HTML document displayed by the web browser of the client device using a mouse." This depressing and releasing a control element defined within a web browser to control a scanner is not disclosed in the LEADTOOLS disclosure, and to the extent that the taking of Official Notice contradicts same, Applicant

respectfully traverses it. In particular, the Office Action takes official notice that “using a mouse with a user interface such as a web browser to operate control element in an HTML document was well known at the time the invention was made.” But Claim 10 must be read not in a vacuum as done by the Examiner, but as further limiting Claim 9 – i.e., the control element defined in the HTML document displayed in a web browser can be depressed and released to generate a start scan signal used to control a scanner. Thus, because the taking of Official Notice does not relate to what Claim 10 actually recites, Applicant objects to such Official Notice on the grounds that is not relevant to the issue of obviousness under Rules 401 and 402, Federal Rules of Evidence (FRE). Furthermore, 35 U.S.C. 103(a) requires that the claimed “subject matter as a whole” must be considered in the analysis: piecemeal dissection as done in the Office Action is not permitted. Moreover, taking of such Official Notice can be viewed as an attempt by the Examiner to negative how the invention was made by asserting that because the invention was made using a control element defined within an HTML document displayed on a web browser, which is known in the art, then the rest of the invention must also be known. “Patentability shall not be negated by the manner in which the invention was made.” 35 U.S.C. 103(a). Accordingly, the taking of Office Notice is objected to because: (1) the statement for which Official Notice is taken is irrelevant to the actual limitations of Claim 10; (2) it is an improper attempt to dissect the Claim and thus fails to consider the Claim “as a whole” as required by 35 U.S.C. 103(a); and (3) it is an attempt to negative the manner in which the invention was made, as prohibited by 35 U.S.C. 103(a). Withdrawal of the taking of Official Notice is requested.

Claim 11 recites “transmitting the document data from the scanner to the client device,” “receiving the document data at the client device,” “at the client device, converting the document data into a form that can be displayed within the web browser of the client device,” and “generating a display including the scanned document on the web browser of the client device, based on the document data...” The LEADTOOLS disclosure fails to disclose these steps since it is a development toolkit, and there is no evidence it was ever used to produce an application to perform these functions. Moreover, Claim 11 recites “converting the document data into a form that can be displayed within the web browser of a client device,” and “generating a display including the scanned document on the web browser of the client device.” The LEADTOOLS disclosure certainly does not contain any “clear and particular” teaching, as required by *In re*



*Dembiczak*, of the invention claimed in Claim 11. In fact, the LEADTOOLS disclosure does not even mention a web browser. The LEADTOOLS Scanning section mentions “image acquisition,” but no control of a scanner, let alone from a control element defined within a browser. In fact, the LEADTOOLS Scanning Section states that developers have the option of using the default TWAIN interface provided by the TWAIN datasource (hence, not a web browser) or may by-pass the user interface to create their own (not described in the LEADTOOLS disclosure to be a web browser, nor would a developer likely create their own web browser). The Display section references various forms of image manipulation, totally unrelated to a browser. The Internet/Intranet Imaging section states that the ActiveX plug-in includes features which allow images and annotation files to be read from any URL. Yet it does not mention generating a display of a scanned document within a web browser, as recited in Claim 11. The LEADTOOLS disclosure fails to disclose adjusting an image displayed within a web browser, as recited in Claims 12-16 as amended. More specifically, the LEADTOOLS disclosure fails to disclose “adjusting the display of the document data via the user interface using a control element defined in the HTML document within the web browser” as recited in Claim 12. The LEADTOOLS disclosure also fails to disclose that the adjusting “includes increasing scale of the display of the scanned document (“zooming in”) on the user interface in the web browser” as recited in Claim 13. The LEADTOOLS disclosure fails to disclose that the adjusting includes “decreasing the scale of the display of the scanned document (“zooming out”) on the user interface in the web browser” as recited in Claim 14. The LEADTOOLS disclosure fails to disclose “scaling the display of the scanned document to fit within the document display portion of the display of the user interface in the web browser of the client device” as recited in Claim 15. The LEADTOOLS disclosure further fails to disclose adjusting the display by “generating the display of the scanned document on the user interface in the web browser of the client device with the same scale as the scanned document” as recited in Claim 16. It further fails to disclose “...generating a multiscan mode signal at a user interface of the client device...” as recited in Claim 18 as amended. Although the LEADTOOLS disclosure mentions single or multiple page image acquisition using a scanner, it does not mention actual generation of a signal to control the scanning operations of the scanner within a web browser, but merely “image acquisition” which may involve multiple pages. Claim 19 recites “generating a selection signal

using a control element defined within the HTML document displayed by the web browser at the client device indicating at least one of the first, last, next and previous scanned documents for display,” and “displaying the document data for one of the scanned documents, based on the selection signal...” The LEADTOOLS disclosure fails to disclose these steps of the claimed invention, and is wholly incapable of being used to produce a browser that displays a control element defined in an HTML document that permits multipage scanning. The deficiencies of the LEADTOOLS Internet/Intranet Imaging and Imaging Common Dialog Sections have been previously addressed. With respect to the LEADTOOLS Scanning section, it does disclose single or multi-page acquire, but using standard TWAIN interfaces, not a control element defined in an HTML document within a browser. The LEADTOOLS Format Import / Export Filters Section mentions numerous file formats, but fails to disclose the deficiencies of the other LEADTOOLS Sections relied upon by the Examiner, nor does it disclose anything comparable to the claimed invention. Claim 20 recites “inputting predetermined index data into an index field defined by the HTML document displayed by the web browser of the user interface of the client device,” “generating a send data signal using the control element defined by the HTML document displayed by the web browser of the user interface of the client device,” “transmitting the document data and index data from the client device to a server over an internetwork in response to the send data signal,” “receiving the document data and index data at the server,” and “storing the document data in association with the index data in a database of a data storage unit.” The Annotation feature of the LEADTOOLS disclosure mentions adding an annotation or document markup can be added to a document or image, and also use of an object that is hyperlinked to open a web page, run an application, or fire a user-defined event. However, the LEADTOOLS disclosure wholly fails to disclose inputting index data into an HTML document displayed by a web browser, generating a send data signal using the control element defined in the HTML document, transmitting the document data and index data from the client device to a server (actually, the LEADTOOLS disclosure discloses exactly the opposite flow from a URL into the developer-defined application), receiving the document data and index data at a server (altogether not disclosed in LEADTOOLS disclosure), and storing the document data and index data in a database of a data storage unit (LEADTOOLS disclosure fails to disclose storing document data and index data, particularly not after upload from the client device to the server).

The deficiencies of the LEADTOOLS “Internet/Intranet Imaging” and “Imaging Common Dialogs” Sections have been previously addressed. The LEADTOOLS “Database Imaging” Section discloses use of Visual Basic (VB) data binding, VB JET engine, ODBC, OLE 2.0 server, and an OLE client, for storing images in various file formats in a database. Accordingly, Claim 20 is patentable over the prior art. The LEADTOOLS disclosure fails to disclose any index data input by a user into an HTML document displayed on the web browser of a client device, and received at the server, which has identification data to identify the document, as recited in Claim 21. The portion of the LEADTOOLS Imaging Common Dialogs section relied upon by the Examiner states that “...boxes can be used to extend the Windows common dialogs for FileOpen and FileSave to provide imaging specific capabilities.” However, there is no disclosure of inputting identification data into an index field of an HTML document for association with document data representing a scanned document in the LEADTOOLS Section relied upon by the Examiner. Hence, the LEADTOOLS disclosure fails to disclose generating a send data signal using a control element defined within an HTML document in a web browser to upload document data displayed inside a web browser and identification data associated with the document data that is input into the HTML document displayed in the web browser, over an internetwork to a server for storage in a database. Hence, the LEADTOOLS disclosure necessarily also fails to disclose that “document data and the index data are transmitted between the server and client device in hypertext transfer protocol (HTTP)” as recited in Claim 22. Claim 23 recites that “the start scan signal and the send data signal are input by a user via a common control element defined in the HTML document displayed by the web browser that toggles between a first scan mode for the performance of said step (a) and a second send mode for the performance of said step (l).” As conceded by the Office Action, the LEADTOOLS disclosure fails to disclose this feature of the claimed invention, which greatly simplifies the work of a coder, for example. The Examiner again attempts to dissect the Claim by taking Office Notice that use of a toggle as a control element within an HTML document displayed in a web browser is known in the art. But this is not what Claim 23 recites. Accordingly, the taking of Official Notice is traversed on the ground that the premise upon which Official Notice is taken is irrelevant to what Claim 23 actually recites under Rules 401 and 402, Federal Rules of Evidence. Moreover, 35 U.S.C. §103(a) requires that Claim 23 not be considered in a vacuum,

but as a part of the Claim “as a whole.” The taking of Official Notice in the manner done by the Examiner isolates the fact that the control element is defined within an HTML document and toggles with each successive activation so as to alternately scan a document, and transmit it over a network for storage. This toggling of functionality for a control element defined in an HTML document displayed within a web browser, has not been done. Thus, the taking of Official Notice is traversed on the basis that it fails to consider Claim 23 “as a whole” as required by 35 U.S.C. 103(a). Lastly, the Examiner has attempted to take Official Notice that toggling of a control element within an HTML document was known. Because the claimed invention was made to include this feature, the taking of Official Notice is an attempt to marginalize the invention because it incorporates something that was known in the art, despite the fact that most inventions are combinations of old elements. Properly viewed, the taking of Official Notice is an attempt by the Examiner to negative the invention by the manner in which it was made, in contravention to 35 U.S.C.103(a). Accordingly, the taking of Official Notice is traversed for at least these reasons. Claim 24 recites that “...the start scan signal is input by a user via a first control element defined in the HTML document displayed by the web browser for a first scan mode in the performance of said step (a) and the send data signal is input by a user via a second control element in the performance of said step (l).” As conceded by the Office Action, the LEADTOOLS disclosure discloses no such control elements. Moreover, the LEADTOOLS disclosure contains no mention of any start scan signal or send data signal generated by control elements defined in an HTML document within a web browser, to cause a scanner to scan a document to generate document data, and to upload document data to a server via a network, respectively. Accordingly, Claim 24 is patentable over the prior art. Claim 25 recites “transmitting the document data from the client device to a server.” The LEADTOOLS application discloses exactly the opposite flow by downloading a bitmap or annotated image file from a URL – no mention is made of uploading in the opposite direction. Claim 26 as amended recites “transmitting the document data from the scanner to the client device,” “receiving the document data at the client device,” and “transmitting the document data from the client device to a server.” Again, the LEADTOOLS disclosure does not disclose uploading document data from a client device to a server. Accordingly, for these reasons as well as for those stated above

with respect to Claim 9, it is submitted that Claims 10-16 and 18-26 would not have been obvious to a person of ordinary skill in the art and thus are patentable over the prior art of record.

For reasons previously stated, Claim 27 patentably distinguishes over the prior art. In particular, Claim 27 recites “generating a start scan signal using a control element defined by a hypertext mark-up language (HTML) document displayed by a web browser of a user interface of a client device.” This step is not disclosed in the LEADTOOLS disclosure: there is simply no mention of any control element defined in an HTML document displayed in a web browser. Claim 27 also recites “at the client device, converting the start scan signal into a form compatible with the scanner,” “transmitting the converted start scan signal from the client device to a scanner,” “receiving the converted start scan signal at the scanner,” and “scanning a document with the scanner to generate document data, in response to the converted start scan signal.” None of these steps is disclosed in the LEADTOOLS disclosure, which only mentions image acquisition, but not control of a scanner. Claim 27 further recites “transmitting the document data from the scanner to the client device,” “receiving the document data at the client device,” “at the client device, converting the document data into a form that can be displayed by the web browser of the client device,” “generating a display including the scanned document in the HTML document displayed within the web browser of the user interface of the client device, based on the document data converted...” Again, LEADTOOLS disclosure fails to disclose at least conversion of document data at the client device and display in an HTML document within a browser, as recited in Claim 27. Moreover, Claim 27 recites “inputting predetermined index data into a field defined in the HTML document displayed by the web browser of the user interface of the client device, the index data associated with document data displayed by the web browser.” The LEADTOOLS disclosure fails to disclose inputting index data in a field defined in an HTML document for association with document data displayed therein. Claim 27 further recites “generating a send data signal using a control element defined in the HTML document displayed by the web browser of the user interface of the client device,” “transmitting the document data and index data from the client device to the server over an internetwork in response to the send data signal,” “receiving the document data and index data at the server,” and “storing the document data received in step (m) in association with the index data in a database of a data storage unit.” The LEADTOOLS disclosure fails to disclose a control element defined

within the HTML document displayed on a web browser, that is used to generate a send data signal to transmit document data and associated index data to a server over an internet network, for storage in a database. The method of Claim 27 greatly simplifies activities of a coder, for example, in scanning and indexing documents for upload to a remote server. Thus, Claim 27 would not have been obvious to a person of ordinary skill in the art, and thus patentably distinguishes over the prior art.

Claims 29-33 and 35-40 depend from Claim 27 and include all of the limitations of that Claim plus additional limitations that are not taught or suggested by the prior art. For example, Claim 29 as amended recites “adjusting the display of the scanned document via a control element defined in the HTML document displayed in the web browser of the client device.” The prior art fails to disclose these features of the claimed invention. In particular, the LEADTOOLS disclosure fails to disclose adjusting a display with a control element defined in an HTML document displayed within a web browser, as recited in Claim 29. Claims 30-33 disclose various scale adjustments that can be accomplished using a control element defined within the HTML document, a feature not disclosed in the LEADTOOLS disclosure. Specifically, the user can operate a control element defined within the HTML document displayed by a web browser by “increasing the scale of display of the scanned document (“zooming in”)” in Claim 30, “decreasing the scale of the display of the scanned document (“zooming out”)” in Claim 31, “scaling the display of the scanned document to fit within the document display portion of the display” in Claim 32, and “generating the display of the scanned document on the user interface of the client device with the same scale as the scanned document” in Claim 33. Although the LEADTOOLS Scanning section mentions use of TWAIN functions to offer control over image size, position, and orientation, it fails to mention use of a control element defined in an HTML document within a web browser for adjusting an image, a feature which greatly simplifies and standardizes equipment needed by coders to perform their work. Thus, Claims 30-33 would not have been obvious to a person of ordinary skill in the art. Claim 35 as amended states “generating a multiscan mode signal using the control element defined in the HTML document displayed by the web browser of the user interface of the client device, said steps (e) - (g) repeatedly performed to generate document data for a plurality of documents, based on the multimode scan signal.” The LEADTOOLS disclosure fails to disclose any control element

defined in an HTML document, that is used to generate a multiscan mode signal to control a scanner. Claim 36 recites “generating a selection signal using a control element defined in the HTML document displayed by the web browser at the client device indicating at least one of the first, last, next and previous scanned documents for display,” and “displaying the document data for one of the scanned documents, based on the selection signal.” Although the LEADTOOLS Scanning section mentions “multipage acquire,” it does not mention use of a control element defined in an HTML document within a web browser to generate a selection signal to designate first, last, next or previous scanned documents as recited in Claim 36. Thus, Claim 36 would not have been obvious to a person of ordinary skill in the art considering the LEADTOOLS disclosure. Claim 37 recites that the index data includes predetermined identification data to identify the document. Although the LEADTOOLS disclosure mentions an annotation object which can be text and that can be used with a document or image, the LEADTOOLS disclosure fails to disclose any use of the annotation object to identify a document for purposes of indexing it. Claim 38 recites that the document data and the index data are transmitted between the server and client device in hypertext transfer protocol (HTTP) format. This feature is not disclosed in the LEADTOOLS disclosure, which at best discloses the opposite flow from a URL to a client computer. Claim 39 recites that “the start scan signal and the send data signal are input by a user via a common control element defined in the HTML document displayed by the web browser of the client device that toggles between a first scan mode for the performance of said step (a) [to control the scanner to scan a document] and a second send mode for the performance of step (l) [to transmit the document data and associated index data from client device to server.]” The LEADTOOLS disclosure fails to disclose any control element defined by an HTML document displayed by a web browser, that can be used to control multiple functions of scanning and transmitting document data. Claim 40 recites that “the start scan signal is input by a user via a first control element defined by the HTML document displayed by the web browser of the client device for a first scan mode in the performance of said step (a), and the send data signal is input by a user via a second control element defined by the HTML document displayed by the web browser of the client device in the performance of said step (l).” The LEADTOOLS toolkit fails to disclose control elements defined in an HTML document that can be used to generate start scan signal to control a scanner, and a send data signal to transmit document data to a server.

Thus, for these reasons as well as those stated above with respect to Claim 27, Claims 29-33 and 35-40 would not have been obvious to a person of ordinary skill in the art, and thus are patentable over the prior art.

Claim 41 recites “a processor operating under a predetermined control program stored in the memory to generate a display based on a hypertext mark-up language (HTML) document on the display unit, the display generated by the HTML document including a document display portion, an index field portion, and a control portion, the document display portion displaying document data generated by scanning the document with the scanner, the index field portion permitting index data to be input via the input device for association with the document data, and a control portion including at least one control element for use in generating at least a start scan signal with the input device to initiate scanning of the document with the scanner and for use in generating a send data signal with the input device to transmit the document data with the index data to the server.” As previously explained, the LEADTOOLS disclosure fails to disclose any processor that generates a display based on an HTML document that includes a document display portion for displaying document data generated by a scanner, an index field portion for inputting index data in association with the document data, and a control portion with a control element that can be used to initiate scanning of a document and uploading document data with index data from a client device to a server. Thus, it is submitted that Claim 41 would not have been obvious to a person of ordinary skill in the art, and thus is patentable over the prior art of record.

Claims 42-49 depend directly or indirectly from Claim 41 and include all of the limitations of that Claim plus additional limitations that are not disclosed in the prior art. For example, Claim 42 recites that “the control element alternates between generating the start scan signal and the send data signal between successive activations of the control element with the input device.” The LEADTOOLS disclosure fails to disclose a control element defined by an HTML document displayed within a web browser, let alone one that can be successively activated to control a scanner to scan a document, and then upload scanned document data to a server. Claims 43-47 recite that the control element can be used to perform various scaling operations on document data displayed within the web browser, using a control element defined in the HTML document displayed in the web browser, none of which is disclosed in the



LEADTOOLS disclosure. In addition, Claim 48 recites that the control element can be used with the input device to select document data from among a plurality of scanned documents for display on the document display portion of the display. No control element defined by an HTML document displayed within a web browser is disclosed in the LEADTOOLS disclosure, let alone one that can be used to select document data for display. Claim 49 recites that “the server receives document data and index data from the client device...” and further recites a “database storage unit coupled to the server, for storing the index data in association with the document data from the processor.” The LEADTOOLS disclosure fails to disclose any client device that receives scanned document data from a scanner, and transmits it along with index data to a server for storage in a data storage unit. There is no mention whatsoever of this configuration in the LEADTOOLS disclosure. Accordingly, for these reasons as well as those stated above with respect to Claim 42, it is submitted that Claims 42-49 would not have been obvious to a person of ordinary skill in the art, and thus are patentable over the prior art.

Similarly, Claim 50 recites a client device, a scanner coupled to the client device, a server coupled to the client device via the network, and a database storage unit coupled to the server. This configuration of elements is not disclosed in the LEADTOOLS disclosure. Moreover, Claim 50 further recites:

the client device receiving document data generated by the scanner by scanning a document, the client device having a user interface capable of generating a display by execution of an hypertext mark-up language (HTML) document by the client device, the display including a document display portion, an index field portion, and a control portion., the document display portion displaying document data generated by scanning the document with the scanner, the index field portion permitting index data to be input via an input device of the client device for association with the document data, and the control portion including at least one control element for use in generating at least a start scan signal with the input device to initiate scanning of the document with the scanner and for use in generating a send data signal with the input device to transmit the document data with the index data to the server, the server storing the document data and index data in the database storage unit.

The LEADTOOLS disclosure fails to disclose any client device that executes an HTML document to generate a display with a document display portion that displays scanned data, an index field portion that can be used to input index data for association with the document, and a control portion that can be used to generate a start scan signal to initiate scanning of the document with the scanner, and for generating a send data signal to transmit the document data with index data to a server that stores the document data and index data in the database storage unit. Accordingly, Claim 50 would not have been obvious to a person of ordinary skill in the art, and thus is patentable over the prior art of record.

Claims 51-53 depend from Claim 50 and include all of the limitations of that Claim plus additional limitations that are not disclosed in the prior art. For example, Claim 53 recites that “the user interface includes a web browser that executes the HTML document to generate the display.” The LEADTOOLS disclosure fails to disclose use of a web browser to generate a display with a document display portion, index field portion, and control portion. Accordingly, for this reason as well as those stated above with respect to Claim 50, Claims 51-53 would not have been obvious to a person of ordinary skill in the art, and thus are patentable over the prior art.

Claim 55 recites a plurality of subsystems including client devices, a server, and a database storage unit. The LEADTOOLS disclosure fails to disclose any such configuration in which multiple client devices use a server and database storage unit to store and/or retrieve document data. Moreover, Claim 55 recites “a plurality of subsystems coupled to the network, the subsystems having respective client devices capable of displaying document data included within respective hypertext mark-up language (HTML) documents displayed on corresponding web browsers thereof, at least one of the subsystems including a scanner coupled to a respective client device, the scanner generating the document data by scanning a document based on a first command from a user entered into the browser of the client device coupled to the scanner, the client device receiving the document data from the scanner and generating a display of the document data in the browser thereof, the client device transmitting the document data based on a second command from the user entered into the browser of the client device; at least one server coupled to the network, the server receiving the document data from the client device over the network; and a database storage unit coupled to the server, the database storage unit storing the

document data so that the subsystems can access the document data.” The LEADTOOLS disclosure fails to disclose at least one client device for controlling a scanner to generate document data based on a command entered into the browser of the client device, and a second command entered into the browser for transmitting the document data to a server for storage in a database storage unit. At best, LEADTOOLS disclosure discloses the opposite flow from a URL to a client computer (even this reverse flow is not clearly and particularly disclosed, as required by *In re Dembiczak*). Thus, Claim 55 would not have been obvious to a person of ordinary skill in the art, and thus is patentable over the prior art.

Claim 56 depends from Claim 55 and includes all of the limitations of that Claim plus the additional limitation that the network includes an internetwork. The LEADTOOLS disclosure fails to disclose transmission of document data from a client device to a server, let alone over an internetwork. Accordingly, Claim 56 would not have been obvious to a person of ordinary skill in the art, and thus is patentable over the prior art for this reason as well as that stated above with respect to Claim 55.

With respect to Claim 57, the LEADTOOLS disclosure fails to disclose “generating a display including a view of a scanned document with a browser of a client device based on document data derived from a scan of a document,” “inputting predetermined index data into the browser of the client device,” and “generating a send data signal from within the browser of the client device.” These steps are simply not disclosed in the LEADTOOLS disclosure. Moreover, Claim 57 recites “transmitting the document data and index data from the client device to the server over an internetwork in response to the send data signal,” “receiving the document data and index data at the server,” and “storing the document data in association with the index data in a database of a data storage unit.” The LEADTOOLS disclosure at best discloses receiving an image from a URL at a client computer (this is not even clearly and particularly disclosed as required by *In re Dembiczak*), as opposed to uploading document data and corresponding index data to the server for storage in the database storage unit, as recited in Claim 57. These features permit documents to be rapidly scanned, indexed, and uploaded to a server for storage in a database storage unit, where the scanned document can be archived and accessed remotely, for example. The LEADTOOLS disclosure fails to disclose these features of the claimed invention,

or the advantages made possible thereby. Thus, Claim 57 would not have been obvious to a person of ordinary skill in the art, and accordingly is patentable over the prior art.

Claims 58 and 59 as amended depend from Claim 57 and include the limitations of that Claim plus additional limitations that are not disclosed in the prior art. For example, Claim 58 recites that “the display of the scanned document is included in a hypertext mark-up language (HTML) document displayed by the browser of the client device’s user interface.” There is no disclosure of displaying a scanned document within an HTML document displayed by a browser in the LEADTOOLS disclosure. Furthermore, Claim 59 recites that “the send data signal is generated by activating a control element defined in the HTML document.” The LEADTOOLS disclosure fails to disclose any control element defined in an HTML document, let alone one used to generate a send data signal to transmit document data and index data to a server for storage in a database storage unit. Accordingly, for these reasons as well as those stated above with respect to Claim 57, Claims 58 and 59 would not have been obvious to a person of ordinary skill in the art, and accordingly, Claims 58 and 59 are patentable over the prior art.

### **C. Objective Evidence of Nonobviousness**

*Graham v. John Deere, Inc.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 USPQ 459, 465 (1966) holds that among the objective evidence that must be considered in an obviousness determination. Objective evidence includes: (1) commercial success of the invention; (2) existence of a long-felt need in the art for the invention; (3) failed attempts of others; and (4) evidence of copying of the invention by others. *Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996). Evidence on each of these points is provided below.

#### **1. Commercial Success of the Invention**

##### **A. Applicant’s Customers Testimony Indicates Commercial Success of the Invention**

Attached as Exhibits 1 and 2 are the declarations of Sisters of Charity Healthcare, Leavenworth, Kansas and Seton Healthcare Network, Austin, Texas, significant customers of the eWebcoding system of assignee InterTech Information Management, Inc. (“InterTech”), which incorporates the claimed invention. As indicated in Exhibits 1 and 2, Ms. MaryAnne Pace and

Ms. Teresa Benavidez testify that they have significant influence over purchasing decisions related to systems used by their hospitals to scan and index medical images required for the hospital to obtain revenue for its operations. Ms. Pace and Ms. Benavidez indicate that their hospitals tried several other competitive products before settling on purchasing InterTech's eWebCoding system due the fact that it was less expensive than other options and easier to use. Ms. Pace and Benavidez further testify that the eWebCoding system has performed satisfactorily for the hospital for many years. Ms. Pace and Ms. Benavidez attribute significant value to the fact that their hospitals' coders operate the eWebCoding using a web browser, with which they are already familiar from their use of the Internet, to control the scanner to scan a document, adjust the display of the document if necessary, index the scanned document, and upload it to a remote server for storage, all from within the web browser. These features make it possible for the coder to take relatively few actions to scan, adjust if necessary, index, and upload the scanned document to a remote server. For example, Ms. Pace and Ms. Benavidez attribute significant value to the fact that the mouse can be left in one place while pressing it to alternatively scan and upload a document. In addition, Ms. Pace and Ms. Benavidez state that the productivity of the coders is enhanced by enabling them to work anywhere, and does not require installation of any specialized software beyond the ActiveX controls needed to scan and upload documents. In addition, Ms. Pace and Ms. Benavidez indicate that because most coders are familiar with web browsers, they can be trained relatively easily in the use of the eWebCoding system.

Exhibit 3 is the declaration of Kevin Bennett, InterTech's CFO. Kevin testifies in paragraphs 4-6 that Sisters of Charity Healthcare, Inc. and Seton Healthcare Network, Inc. are representative of the majority of customers of InterTech's eWebcoding system, and that the experience, use, and impressions of the majority of other customers are similar to those of the Sisters of Charity Healthcare, Inc. and Seton Healthcare Network, Inc.

#### **B. Applicant's Sales of Claimed Invention Demonstrate Commercial Success**

Again referencing Kevin Bennett's declaration, paragraphs 14-15, he indicates that InterTech's eWebcoding system which incorporates the claimed invention are \$2.4 million, \$4.5

million, and \$6.6 million for successive years 2001-2003. This significant and explosive growth in revenue is reflective of the commercial success of InterTech's eWebcoding system, and can be ascribed in significant part to the claimed features of the invention.

The Applicant's sales of the claimed invention demonstrate its commercial success. In particular, Exhibit 4 is a press release stating:

**INTERTECH INFORMATION MANAGEMENT, INC.  
ANNOUNCES APPLICATION SERVICE PROVIDER MODEL**

**Washington Document Service becomes first customer to  
outsource InterTech solutions**

Dallas, TX, September 22, 1999 – Washington Document Service (WDS), a ChoicePoint Company, is InterTech's first implementation of an extranet designed to enable business transactions that involve documents over the web. WDS is also its first customer to outsource the deployment and maintenance of an electronic document management solution from the Atlanta-based software company.

The above press release is evidence of significant commercial success of the claimed invention and its ASP model, as evidenced by the implementation of WDS, a significant document management company.

Exhibit 5 includes the following excerpt from a press release:

**INTELLISYS USES INTERTECH SOLUTION TO HELP  
ASCENCUS AND CAN LIFE CUT COSTS AND DECREASE  
PROCESSING TIME WITH NEW IMAGING SYSTEM**

Los Angeles, California, November 4, 1999

\* \* \*

Currently, Ascensus is transmitting 100 documents a day to CNA via the Intellisys / InterTech system, according to Erin Anders, senior project manager for CNA Life. "We no longer have to wait for the paperwork to be shipped manually to start processing which saves us a day. We also benefit by not having to scan or index the documents into our own system, which saves us another day.

Once we receive the images and index data, they are matched up and automatically put into a queue. These queues are designed to route data and images through specific workflows that maximize our efficiency in processing the information. We are so comfortable and confident with how the system is working that we are having the original documents shipped to our warehouse, as opposed to having them shipped to our processing office,” said Anders. According to Susan McGory, president and COO, CNA Life / LTC strategic business units, “This process allows us to begin underwriting quicker, and, in turn we issue and place policies in a much more time and cost efficient manner. It really translates into increased efficiencies for the client, the broker, and the company.”

“Intellisys’ main goal is to cut costs and reduce the time it takes for insurance agents and carriers to process applications, which in turn will help grow their business and enhance their customer service,” said Jeffrey C. McCauley, vice president, Osborn Group. “We are pleased to see that Ascensus and CNA Life are already experiencing a cost savings and a time savings. These initial results will incent us to work even harder in bringing enhanced value and efficiency to our service offering.”

Hence, the above press release establishes that the claimed invention provides significant cost and reduces time of processing documents, which are factors contributing to the commercial success of the claimed invention.

Exhibit 6 is an excerpt from a press release stating:

#### INTERTECH SIGNS FIRST HEALTHCARE CUSTOMER TO ITS ASP SERVICE

Atlanta, April 10, 2000 – InterTech Information Management Inc, developers of the award-winning DocuPACT™, one of the foremost electronic document management systems in the industry, has recently signed its first customer (Inova Fairfax Hospital) to its Application Service Provider (ASP) service called eWebCoding. InterTech’s ASP service includes hosted “document commerce” applications on a pay-as-you-go plan.

eWebCoding™ is a solution for remotely coding patient medical records in the healthcare industry. Inova Fairfax Hospital is

eWebCoding's first implement of this Internet-based solution that allows medical record coders to work from any remote location, including home.

"With today's shortages in qualified medical record coders, we needed a more creative way to attract and retain coding staff," stated Jennifer Shearer, RHIA, Director of Medical Records, Inova Fairfax Hospital. Staffing shortages negatively impact timely coding which is critical to a hospital because it starts the reimbursement and billing processes and impacts revenue.

The above press release establishes the value of the claimed invention in permitting coders of medical documents to remotely, such as from home. This is an attractive feature of the claimed invention to coders that the Applicant's customers want to hire, and also enables the hospital to retain coders. Given that the coding of the documents impacts the hospital's revenue, an important reason for the commercial success of the claimed invention is apparent.

Exhibit 7 is an excerpt from a press release which states as follows:

**BEST PROFESSIONALS IN THE BUSINESS ADD  
EWEBCODING TO LIST OF SERVICE OFFERINGS**

Health Record Services and eWebCoding offer Internet-based coding.

Atlanta, Georgia, June 1, 2000. eWebcoding, a division of InterTech Information Management, Inc., is pleased to announce that Health Record Services Corporation (HRS), the quality leader in cost-effective coding and education training services for healthcare providers, will offer remote coding services using eWebcoding's secure application service provider (ASP) solution.

Connecting Twenty Years of HIM Experience with Innovative Internet Technology "When I started HRS in the 1970s, the ability to code medical records from remote locations and from home was a distant dream," states Wendy Coplan, RHIA, President, Health Record Services. eWebcoding has made that dream a reality. Now HRS can offer its clients and prospective clients a secure on-line coding service option that has never before been available.



“HIM professionals constantly need to find better solutions for their acute, day-to-day business problems,” explains Coplan, “and eWebCoding is one of those solutions.” Even if the client has an all-paper medical record, eWebCoding will enable HRS coders to work from remote locations, and Coplan will be able to reduce turnaround time and use her most-qualified coders for more productive hours. “HRS is pleased to boast a full complement of experienced and multi-credentialed coders,” adds Coplan. Many staff members want to work additional hours, but can’t do additional traveling. “With eWebCoding, these top-flight professionals will be able to do more work in less time, and with no compromise in quality,” states Coplan.

#### HRS Clients Can Eliminate Expenses

“With eWebCoding, our clients will also be able to eliminate costly travel expenses,” explains Coplan. Healthcare providers can now engage HRS to provide accurate coding at less expense, and without compromising confidentiality and reliability. These savings will increase, because future plans call for expansion of the eWebCoding solution into HRS physician coding, compliance, and coding audit services.

Thus, the above document indicates that the features of the claimed invention which enable coders to work remotely are identified as factors contributing to the commercial success of the claimed invention.

Exhibit 8 states:

#### JOINT STAFF AND ARLINGTON AND INOVA FAIRFAX HOSPITALS SELECT INTERTECH’S WEB-BASED DOCUMENT MANAGEMENT SOLUTION

Atlanta, Georgia, August 9, 2000. InterTech announced today that the Joint Staff is among several Washington DC-based organizations that selected InterTech Information Management Inc. to provide them with a web-based document management and workflow solution. The Joint Staff will integrate InterTech’s DocuPACT product with their workflow system and Records Management Application (RMA). The Joint Staff supports the U.S. Joint Chiefs of Staff that provides military guidance and recommendations to the Secretary of Defense and the President of the United States.

\* \* \*

Atlanta-based InterTech, one of the leading web-based software and applications service providers of document management and workflow solutions, was chosen after a thorough product search and review process by the Joint Staff Implementation Working Group.

\* \* \*

The other Washington, DC-based customers of InterTech include Arlington Hospital, Arlington, Virginia's largest and most comprehensive hospital, and Inova Fairfax Hospital, a top 100 hospital.

Inova and Arlington will be utilizing eWebCoding™, an Application Service Provider (ASP) solution from InterTech. eWebCoding is a new Internet solution that allows coders to work from any remote location, including home. Coders are highly trained, certified staff who assign diagnostic and procedure codes for services of hospitals and other care providers.

These codes determine the level of reimbursement received. Therefore, coder services enable a healthcare organization to maintain a steady, even cash flow. Like most ASP services, eWebCoding requires no up-front investment, no capital outlay and no specialized skills by the customer.

Both Arlington and Inova are very excited about the future of eWebCoding and its contribution to their organizations. "We are really looking at eWebCoding as a retention process for us," said Susan Waldron, director of Health Information management for Arlington Hospital. "We've just started, but our staff is extremely enthusiastic about being able to work from home with eWebCoding. We are fully staffed right now, but we've had a lot of turnover in the past couple of years. So, I'm looking forward to retaining my current coders, and should one of them leave the area, hopefully, they can still connect with us through eWebCoding. But, if not for some reason, then its still a real plus to be able to hire."

According to Inova's Director of Medical Records, Jennifer Shearer, she has had a tremendous response to the eWebCoding

solution from both her management and the coders. "My management was very excited by the eWebCoding idea because they are so aware of accounts receivables on a daily basis and the impact that not having enough qualified coders has on accounts receivables," said Shearer. "As far as my coders go, they thought it was great. They couldn't wait, and I don't think we could have implemented it fast enough to make them happy."

"InterTech is extremely pleased to be selected by the Joint Staff, Arlington Hospital, and Inova Fairfax Hospital as their document management solution providers," said Steve Hindman, president of InterTech. "The work that the Joint Staff is doing is crucial to the state of our nation, and we at InterTech are proud to be associated with such an outstanding operation. We are also dedicated to developing ASP solutions which help solve critical business problems such as the coder shortage. InterTech realizes how crucial a hospital's services are to a community, and the support needed to keep those services running. We are pleased to contribute to such a cause."

The above evidence establishes major commercial success of the claimed invention, which includes the Joint Staff, Arlington Hospital, and Inova Fairfax Hospital. In addition, the above evidence establishes several features of the claimed invention deemed important. For one, the web browser-based implementation enables coders to work remotely, such as from home, enhancing coders' productivity. Hence, the customer is able to hire and retain coders. In addition, the ability to readily hire coders alludes to the ease of use of the claimed invention and how that contributes to the commercial success of the invention. The impact that efficient coding has upon a hospital's accounts receivables is also stated in the above press release, a feature that greatly contributes to the commercial success of the invention.

**C. Proliferation of Similar or Identical Products After the Filing Date of the Claimed Invention as Evidence of Commercial Success of the Invention**

The following evidence establishes that numerous products with similar or identical capabilities to the claimed invention have been introduced into the marketplace after the filing date of the subject application. These products and the following related statements demonstrate

the commercial success of the invention, providing further objective evidence of non-obviousness of the claimed invention.

Exhibit 9 from the Kofax website entitled "Distributed Data and Document Capture: Cost and Architecture Issues, May 2002, states:

This year, an even lower cost option emerged which can put production capture on every desktop. For as little as \$15,000 for an unlimited number of desktops, it teams existing networked copiers for scanning with browser-based capture software."

\* \* \*

The Ascent® family of distributed capture products – Ascent Capture Internet Server™, Ascent Ricochet™ and Ascent Web Validation Server® - has been designed with these issues in mind. Ascent enables document and data to be captured when and where they enter the organization, indexed and verified locally or anywhere in the world and then released to one or more Enterprise Document Management or Enterprise Content Management systems for online access and workflow.

\* \* \*

#### Extending the Capture Architecture to Every Desktop

As mentioned above, some business processes work most efficiently, when the document creators and contributors – the knowledge workers – scan and index their own work.

\* \* \*

#### Extensible to Every Enterprise Desktop:

Enables Content experts and creators to scan, index and launch workflow for their own projects. Should use familiar office technology, e.g., copiers for scanning; Web browser for indexing and assembly. (Ascent Ricochet).

Exhibit 10 entitled "Ascent Ricochet – Product Overview" states:

Everyone knows how to use a Web browser and an office copier. Now, Ascent Ricochet, the latest browser-based extension of

Ascent Capture, enables any knowledge worker to employ these simple tools to initiate production document workflow for the important document packages they help create.

\* \* \*

However, when volumes are small but captured documents must still enter a designated workflow, Ascent Ricochet may be the best choice. It enables the knowledge worker to initiate this workflow using their desktop Web browser and the nearest digital copier or multifunction peripheral (MFP).

The Ascent Ricochet – product overview also discloses a display that appears to have a document display portion, index field portion, and control portion, all defined within a web browser, as in the claimed invention, as more clearly seen in the expanded view of the browser window.

Exhibit 11 includes a customer of Kofax Ascent Capture product that states:

“Now that remote document capture has been installed in some of our branches, I’m already getting call from out other offices demanding we install it,” says Janie Bookout, a partner at J.C. Bradford & Company, a full-service financial brokerage with nearly 100 offices nationwide.”

This indicates that the customers recognize the value of products like the claimed invention, which fuels its commercial success.

Exhibit 12 is a document regarding ImageNet™ product of Hershey Technologies, Inc., which states:

ImageNet™ is a browser-based document imaging storage and retrieval system that integrates tightly with front-end document capture products such as Cardiff Software’s TELEform™ and Kofax Image Products’ Ascent Capture™.

\* \* \*

Browser-Based User Access

The ImageNet server runs on Internet Information Server with Windows NT 4.0 or Windows 2000. Image retrieval is performed using Internet Explorer (4.x or 5.x) or Netscape Navigator (4.7x or 6.x).

\* \* \*

#### Web-Based Index/Correction

If your application requires a browser-based method for indexing or verifying your scanned images, then you can scan your images directly to ImageNet and let your data entry staff enter the index data from a web browser.

The above excerpts appear to state that the browser display has an index field portion, and the shown browser interface clearly has a document display portion and a control portion, as recited in the claimed invention.

Exhibit 13 includes excerpts from The Imaging Solutions website disclosing WebNow and CaptureNow software products. The excerpt regarding the WebNow product states:

WebNow is PVI's browser-based solution for use with ImageNow document imaging, management & workflow software.

The portion of the Imaging Solutions website addressing the CaptureNow product states:

CaptureNow is ImageNow's complete, secure scanning subsystem that provides a host of centralized and/or distributed scanning functionality across your entire enterprise.

\* \* \*

#### Package Capture

Quickly complete a folder of required documentation by scanning a group of documents in any order and using a drag & drop interface to assign index values.

\* \* \*

#### Capture Profiles

Define virtually any hardware and software setting you need to optimize your scanning environment - ...orientation,...duplex scanning, ....

\* \* \*

#### Internet Capture

Scan documents from anywhere in the world and take full advantage of all CaptureNow's functionality via your Intranet or the Internet.

\* \* \*

#### Workflow Indexing

Index values can be created, modified or added in ImageNow Workflow via Integrated keyless indexing or via scripted indexing, which collects index values from or validates them against external data sources.

#### Manual Indexing

CaptureNow supports manual indexing where integrated or automatic indexing methods are not possible.

Scripted Indexing – CaptureNow provides the ability to collect index values from external data sources and to validate index information during or immediately after an index event.

Hence, it can be seen that this product has numerous features in common with the claimed invention, providing further evidence of the commercial demand, and therefore success, of the claimed invention.

Exhibit 14 regarding the “imageWARE Document Manager 2001 Workgroup Edition” states as follows:

#### ImageWARE Document Manager 2001 Workgroup Edition

ImageWARE Workgroup Edition is a 10 user, entry-level document management system. Workgroup is designed to help small offices or individual departments acquire, manage, store, and retrieve documents that would normally not be shared in a secured manner.

### ImageWARE Scan Manager 2001

ImageWARE Scan Manager is a software application used to efficiently capture and index large volume of documents for storage and retrieval. Document files processed by imageWARE scan Manager can be released (transferred) to imageWARE Document Manager for storage and viewing.

The ImageWARE product does not specifically mention use of a web browser like the claimed invention, but is one more product offering some scanning and indexing features which contribute to the commercial success of the claimed invention.

Exhibit 15 is a document from ScanPortal Technologies, Inc. which states as follows:

ScanPortal Web Capture is an Internet-based content management system that will revolutionize the way your company works with both paper documents and electronic files!

Scan Portal Web Capture enables your Web browser to scan and process (when connection to a TWAIN compliant scanner), drag and drop files from any Internet-connected PC to Web document repositories and/or CD archives for secure 24/7 access.

\* \* \*

### No Up-Front Expense – Immediate Deployment

Scan Portal Web Capture requires NO capital outlays, NO servers to maintain, NO software to install and maintain, and NO drain on IT and human resources.

Implementation is immediate (within 24 hrs. is available). ScanPortal Web Capture clients needs only one or more TWAIN compatible scanner(s) holed up to an Internet connected Windows PC and a standard Web Browser.

\* \* \*

### Features/Benefits

On-demand browser-based scanning



\* \* \*

Scan from multiple locations to centralized document repository

\* \* \*

User friendly. ScanPortal Web Capture is as easy as browsing the Internet Configurable document profiles

Importantly, the browser display of Fig. 3 clearly shows a document display including a document display portion, index portion, and control portion, as in the claimed invention. Accordingly, the existence of this product in the marketplace shows very clearly the commercial success of the claimed invention.

Exhibit 16 is a document from Datacap, Inc.'s website, which states:

#### Task Master Web

When your document capture needs stretch beyond the office walls to remote locations for scanning or indexing. Task Master Web extends Task Master's reach with browser-based tasks. Supervisors and administrators can access Task Master without installing any software on their local computer.

Task Master Web makes it easy to distribute processing to the locations where you want to do the work. Scanning, verifying recognition results, or indexing images in a browser means that distributed offices can scan directly into the central capture system and at home workers can be integrated into your document automation strategy.

\* \* \*

#### Distributed Scanning

When document are received at remote locations, but need to be processed centrally, Task Master Web is a convenient, low-cost solution. With only a scanner and a browser, Task Master Web ties distributed locations together to a central hub of processing.

The user interface of the Task Master Web product contains a document display portion, a control portion, and may well have an index field portion into which a file path can be input

using the browser. Again, this evidence demonstrates yet another product with features very similar or identical to the claimed invention, demonstrating the extensive market for the claimed invention, and hence, its commercial success.

## **2. A Long-Felt Need But Unsolved Need for the Invention Has Existed**

Attached as Exhibit 17 is a brochure entitled "Ascent Capture 5 INTERNET SERVER™" which states:

### **INTERNET CAPTURE VS. TRADITIONAL CAPTURE METHODS**

Today, most organizations that have remote offices are forced to either ship their paper documents to a central site for scanning, scan the document to CD, or rely on low quality faxes. A custom built application is sometimes an alternative, but is both costly and time consuming to maintain.

This excerpt identifies the state-of-the-art existing prior to the claimed invention. Of particular interest is the statement indicating that custom built applications are sometimes an alternative, but are costly and time consuming to maintain. To the extent that a toolkit like that of the LEADTOOLS disclosure could be used to design an application, the above makes it clear that such a custom application is costly and time-consuming to maintain, and hence helps to establish that there was a long-felt need for the claimed invention.

Exhibit 18 includes a document from the Kofax website that states:

### **Distributed Capture Anywhere in the World**

Ascent Capture's Internet-based distributed capture capability eliminates the common and costly practice of shipping documents from remote offices to a central site for processing. The optional Ascent Capture Internet server enables remote scanning and indexing of documents via connections ranging from dedicated lines to inexpensive dial-up service. Now, IT and IS managers can develop and implement an enterprise-wide capture solution that allows documents to be scanned inexpensively at remote sites and then automatically uploaded to the central site, securely and reliably.

\* \* \*

Remote ACIS sites can be installed quickly through Microsoft Internet Explorer on the remote client computer.

Note that the above statement includes “Now, IT and IS managers can develop and implement an enterprise-wide capture solutions...” which means, effectively, they could not previously, indicating a long-felt need for the claimed invention.

Exhibit 19 includes a document from the Kofax website entitled “Case Studies – Financial Brokerage Speeds New Account Applications with Distributed Document Capture” states as follows:

Setting up and operating a document scanner was another roadblock. Unless the solution allowed each local JC Bradford team to scan a variety of documents without frequent, time consuming scanner readjustments and document rescans – a process that has historically plagued electronic document capture – distributed capture still wouldn’t make sense. For Bradford and most other small remote office environments, the scanner operator must simply be able to load the paper feeder and push the scan button.

Thus, because “scanner readjustments and document rescans” have “historically plagued electronic document capture,” and because “the scanner operator must simply be able to load the paper feeder and push the scan button,” it is clear that there was a long-felt need in the art for the corresponding features of the claimed invention.

Exhibit 19 also includes a statement regarding Kofax Ascent Capture product:

“The company already had several years of document imaging experience. They knew that remote capture and electronic workflow were the answers, but until recently no one offered such a product – let alone an application that could remotely capture and synchronize streams of documents from dozens of sites daily.”

This statement of a Kofax customer provides evidence of a long-felt need in the art for the claimed invention. It recognizes the inadequacy of previous attempts to corresponding features

of the claimed invention, and thus demonstrates that the claimed invention satisfies a long-felt need in the art for the claimed invention.

Exhibit 20 is a September 29, 2000 article on the Integrated Document Technologies (IDT), Inc. website states:

Breakthrough Software Enables Web-Based Distributed Document Capture

Chicago-Area Firm Partners In Development of Low-Cost, High-Speed Solution

Integrated Document Technologies, Inc. (IDT) announced today that it is one of the first companies in the U.S. to offer Quillix™, a revolutionary new Web browser-based distributed document capture solution from Prevalent Software, Inc., Colorado Springs, CO. IDT, a leading document management system consultant and software designer, is a development partner and Premier Reseller for the Quillix system, now making it available as part of its full line of document imaging solutions for manufacturers, insurance firms, banks and other financial services organizations.

Quillix is the first truly Browser Based Document and Information Capture system built for the Internet, and the first electronic system to solve the problem of capturing and distributing information inexpensively. "Quillix brings together proven technologies, including open architecture design, TWAIN scanning format and XML-based Internet forms, to bring the promise of Internet distributed capture to life," said Paul Szemplinski, IDT president. "It will save companies millions of dollars and speed their business processes."

The Quillix system offers users significant cost-savings compared with central or distributed document capture systems because it delivers document capture capabilities direct to users via the Web. It, therefore, eliminates the need for system administrators to install proprietary software and expensive scanners at each user station – dramatically lowering the per-user total cost. Additional cost-savings come from the elimination of express-mail and other document shipping expenses.

Low Cost, High Performance

Quillix enables users to scan, index and review paper documents, photographs, and text forms (including legal contracts) using common desktop scanners, digital cameras, Web forms, Web browsers and Web servers. User accounts, privileges and scanning profiles are also defined and managed in a Web browser client application.

\* \* \*

With Quillix, anyone within an organization with a scanner, Internet connection and Web browser can do what entire document capture departments in many companies do," said Szemplinski. "Even if an organization has a thousand remote offices, Quillix makes capturing and sharing the needed information as easy as browsing the Web."

Notice that as of September 2000, thus after the filing date of the claimed invention, the above article characterizes the Quillix system with functionality similar to the claimed invention as "Breakthrough Software," indicating that there was a long-felt need in the art for the functionality provided by such system. Furthermore, this article states that "Quillix is the first truly Browser Based Document and Information Capture system built for the Internet, and the first electronic system to solve the problem of capturing and distributing information inexpensively." The fact that this article, published well after the claimed invention's filing date, indicates that IDT considered the Quillix software to be a "breakthrough" and the first of its kind, demonstrates that there was a long-felt need in the art for the claimed invention.

Exhibit 21 is another document pertaining to the Quillix software, which states:

Prevalent Software, Inc. Introduces Quillix  
Quillix is a Revolutionary New, Browser Based, Distributed  
Capture Solution For The Internet

January 18, 2000  
Colorado Springs, Colorado

Prevalent Software, Incorporated® a leading provider of  
eCommerce automation software, today announced the  
introduction of their newest product, Quillix. The announcement

was made today at the Optika® International Summit where Prevalent is a sponsor.

Quillix is the first true enterprise, distributed capture system built for the Internet. It is designed to provide a low-cost capture solution using TWAIN compliant desktop scanners and XML based Internet forms and runs totally within the Web browser. Whether an organization has one or a thousand remote offices if they depend upon information collected at these locations, Quillix makes capturing and utilizing this information as easy as browsing the web. Off site insurance agents, for example, can scan claim forms and transmit that information to the main office, instantly, over the web.

Prevalent designed Quillix with the assistance of Integrated Document Technologies, Inc. (IDT) a Prevalent development partner. Because of their experience in delivering eCommerce Solutions, IDT was instrumental in the design of Quillix. "Prevalent brings a suite of products to the market that are innovative in the automation of eCommerce Business Processes and invaluable to our customers," said Paul Szemplinski, President of Integrated Document Technologies, Inc. "The promise of workflow automation and the vision of Integrated eCommerce have become a reality for our customers thanks to our relationship with Prevalent. In keeping with their vision Prevalent has developed a revolutionary document and data capture product for the eCommerce industry."

In addition to the innovative browser interface, Quillix also includes a robust and open Web Server component to release scanned documents and information to a wide variety of eCommerce, workflow, document imaging and data capture systems. There is no longer a need for disparate scanning and indexing applications for each document and data management system within an organization. With Quillix just log-on, scan and release the information to the appropriate document or data management system. Because the Quillix Web Server is built on an extensible architecture, release components can easily be built for other systems. Quillix can turn your eCommerce Application into a complete eCommerce Web solution.

Thus, according to Prevalent Software, Inc., "Quillix is the first true enterprise, distributed capture system built for the Internet." Further, IDT's President characterizes the Quillix solution

as “a revolutionary document and data capture product for the eCommerce industry.” This is further evidence of the long-felt need in the art for the claimed invention – to be the “first true enterprise, distributed capture system built for the Internet,” and “revolutionary,” there must have been a long-felt need for the claimed invention (not to mention attempts by others that had failed to attain the claimed invention). Because Quillix appears to contain similar or the same functionality as the claimed invention, it is submitted that there was a long-felt need in the art for the claimed invention that was not satisfied until the claimed invention was made.

Exhibit 22 regarding PeriCAPTURE states:

#### DOCUMENT CAPTURE

##### PeriCAPTURE

PeriCAPTURE by eCapture is one of the most affordable, easy-to-use and innovative document capture solutions available in the market today. It allows you to implement both a production-level and Internet distributed capture system.

\* \* \*

By using ecNet, you can scan documents anywhere in the world and then send those images over the Internet back to a central site. This is a true, browser-based, Internet-distributed system, not just a data link.

Notice the use of the word “innovative” tends to indicate that there was a long-felt need for the claimed invention satisfied through the advent of a solution with functionality close, if not identical, to the claimed invention.

Exhibit 23 states as follows:

2001 Release

3M Health Information Systems Division Launches Outsourced  
Coding Service

Business Editors & Health / Medical Writers

SALT LAKE CITY -- (BW HealthWire) – Oct. 16, 2001

“We know from talking to our customers that the nationwide shortage of qualified coders is a critical problem,” says James Burgess, division vice president, 3M Health Information Systems Division. “Hospitals dealing with this shortage often face a coding backlog that can result in delayed reimbursement when patient records can’t be submitted on time. Customers tell us that backlog conditions, and the challenges involved in recruiting and training new coders, are putting hospital at risk for increased claims denials, additional expense from resubmitting claims and even regulatory compliance problems – all because records may be improperly coded by inexperienced and over burdened coders.”

This evidence establishes that coders are in short supply, and that there is a backlog in coding of documents. Without the coding of documents, reimbursements to the healthcare provider for services are delayed. Furthermore, coders are a challenge to recruit and train, and use of overburdened coders puts the hospital at risk for increased claims denials, additional expense, and regulatory compliance problems. Thus, there has been a long-felt need for the claimed invention.

### **3. Failed Attempts of Others**

Exhibit 19 from the Kofax website entitled “Financial Brokerage Speeds New Account Applications with Distributed Document Capture” states as follows:

Setting up and operating a document scanner was another roadblock. Unless the solution allowed each local JC Bradford team to scan a variety of documents without frequent, time consuming scanner readjustments and document rescans – a process that has historically plagued electronic document capture – distributed capture still wouldn’t make sense. For Bradford and most other small remote office environments, the scanner operator must simply be able to load the paper feeder and push the scan button.

This document makes it clear that the ability to scan a variety of documents without scanner readjustment and document rescans, which have “historically plagued electronic data capture” using a system that an operator can simply load a document and push a scan button, satisfies failed attempts of others to obtain corresponding aspects of the claimed invention.



#### **4. Copying of the Invention by Others**

It is manifestly clear that the Ascent Capture / Ricochet, ImageNet system, Quillix system, ScanPortal Web Capture system, and Task Master Web systems contain functionality similar, and in some cases identical, to the claimed invention. For example, the ScanPortal Web Capture system appears to have a web browser interface with a document display portion, index field portion, and a control portion as defined in the claimed invention. The ImageNet and Task Master Web likewise appear to have these features of the claimed invention. Hence, it is very possible that others are copying the claimed invention. At a minimum, the existence of these systems indicates that the value of the invention is now recognized by others.

#### **New Claims 60-76 Are Patentable Over the Prior Art**

By the present Amendment, Claims 60-76 have been added to the subject application. Claims 60-68 depend, directly or indirectly, from Claim 1 as amended and include all of the limitations of that Claim plus additional limitations that are not disclosed in the prior art. For example, Claim 60 recites "inputting index data identifying the scanned document into the index field portion." The LEADTOOLS disclosure fails to mention inputting index data into the index field portion of an HTML document displayed on a web browser. Claims 61-68 depend from Claim 60 and thus would not have been obvious to a person of ordinary skill for the reasons stated above with respect to Claim 60. In addition, Claim 61 recites that "the index data comprises a document name identifying the scanned document." The prior art fails to disclose input of index data comprising a document name identifying a scanned document into an HTML document for display. Claim 62 recites that "the index data comprises an identification number identifying the scanned document." The LEADTOOLS disclosure contains no mention of any identification number entered into an index field portion of an HTML document displayed within a web browser. Claim 63 recites that "the index data comprises a file path indicating the subdirectory on the server at which the scanned document is to be stored." No input of a file path into the index field portion of an HTML document displayed on a web browser is disclosed in the LEADTOOLS disclosure. Claim 64 recites that "the index data comprises text explaining the nature of the scanned document." The LEADTOOLS disclosure fails to mention input of text explaining the nature of a scanned document into an index field portion of an HTML document displayed by a web browser. Claim 65 recites that "the index data identifies a matter

to which the scanned document relates.” The LEADTOOLS disclosure contains no mention of input of index data into an index field portion of an HTML document displayed on a web browser. Claim 66 recites that “the index data identifies a transaction to which the scanned document relates.” The LEADTOOLS disclosure fails to mention use of index data to identify a transaction to which the scanned document relates. Claim 67 recites “activating the control element using the user interface to scan the document with a scanner to generate the document data.” The LEADTOOLS disclosure fails to mention activating a control element defined within an HTML document to scan a document. Claim 68 recites “activating the control element to upload the document data representing the scanned document to a server over a network.” The LEADTOOLS disclosure fails to mention activation of a control element within an HTML document to upload a scanned document to a server over a network. Accordingly, for these reasons as well as for those stated above with respect to Claim 1 and 60, Claims 61-68 would not have been obvious to a person of ordinary skill in the art.

Claims 69-75 depend from Claim 27 as amended and include all of the limitations of that Claim plus additional limitations that are not disclosed in the prior art. For example, Claim 69 recites that “the index data input in said step (j) identifies the scanned document.” The LEADTOOLS disclosure fails to mention input of index data into a field of an HTML document displayed in a web browser that identifies the scanned document. Claims 70-75 depend from Claims 27 and Claim 69 and thus include all of the limitations of that claim plus additional limitations that are not disclosed in the prior art. For example, Claim 70 recites that “the index data comprises a document name identifying the scanned document.” The LEADTOOLS disclosure fails to mention input of a document name into the field portion of an HTML document displayed by a web browser to identify a scanned document. Claim 71 recites that “the index data comprises an identification number identifying the scanned document.” The LEADTOOLS disclosure fails to mention inputting an identification number identifying a scanned into an HTML document displayed by a web browser. Claim 72 recites that “the index data comprises a file path indicating the subdirectory on the server at which the scanned document is to be stored.” The LEADTOOLS disclosure fails to mention inputting a file path into an index field defined in an HTML document displayed by a web browser. Claim 73 recites that “the index data comprises text explaining the nature of the scanned document.” The

LEADTOOLS disclosure fails to mention any input of text into an index field portion of an HTML document to indicate a subdirectory on the server at which the document is to be stored. Claim 74 recites that “the index data identifies a matter to which the scanned document relates.” The LEADTOOLS disclosure fails to mention inputting index data identifying a matter to which the scanned document relates into the index field portion of an HTML document displayed on a web browser. Claim 75 recites that “the index data identifies a transaction to which the scanned document relates.” The LEADTOOLS disclosure fails to mention inputting index data identifying a transaction to which the scanned document relates into the index field portion of an HTML display generated by a web browser. Accordingly, Claims 69-75 would not have been obvious to a person of ordinary skill in the art.

Claim 76 depends from Claim 55 and further recites that the server is implemented in an application service provider (ASP) environment. This limitation is not disclosed in the LEADTOOLS disclosure, and would not have been obvious to a person of ordinary skill in the art considering such disclosure.

### Summary

Claims 1-16, 18-27, 29-33, 35-53, and 55-59 as amended, and new Claims 60-76, would not have been obvious to a person of ordinary skill in the art. Applicant earnestly requests reconsideration of all pending Claims and withdrawal of the rejection of all pending Claims, and an early Notice of Allowance be issued for all pending Claims.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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